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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,397	06/29/2001	Yasuo Narita	18920.0019	6006

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EXAMINER

OSELE, MARK A

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/893,397

Applicant(s)

NARITA ET AL.

Examiner

Mark A Osele

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) 1,11-13 and 17-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6-29-01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 11-13, drawn to a film transfer apparatus, classified in class 156, subclass 577.
- II. Claims 2 and 14-23, drawn to a method of making a roller with a resilient surface, classified in class 156, subclass 56.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process can be used to make rollers for different apparatuses such as conveyors, printers, or roll presses.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

2. This application contains claims directed to the following patentably distinct species of the claimed invention: Species A, heat shrinking a coating on a

Art Unit: 1734

core (clms 2, 15-16); Species B, swelling a tube in organic liquid before overlaying on core (clms 17-18); Species C, painting a coating on a core (clm 19); Species D, insert molding a covering on a core (clm 20); Species E, placing a tube loosely over a core (clm 21); Species F, extruding core and covering simultaneously (clm 22); Species G, skiving a resin or metallic material (clm 23)..

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 14 is generic.

3. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

4. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence

Art Unit: 1734

now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with Sean O'Hanlon on October 3, 2002 a provisional election was made with traverse to prosecute the invention of Group II, Species A, claims 2 and 14-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1, 11-13, and 17-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1734

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 2 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Aser et al. Aser et al. teaches making a roller by providing a steel core, placing a silicone rubber tube over the core, and heat shrinking the tube to bond the tube to the core (column 3, lines 6-14). The rejection considers the roller of Aser et al. to have a “small diameter” because the limitation intended by “small” is not distinctly defined.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aser et al. in view Nose et al. Nose et al. teaches that resin rollers of a small diameter are typically used in hand held film transfer tools. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the roller of Aser et al. in a hand held film transfer tool because Nose et al. shows the use of a resin roller for this purpose. The rejection is based on a strict reading of the preamble to be interpreted in light of the specification to be directed to rollers in *hand held* film transfer tools.

12. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Aser et al. in view of WO99/30913 (Reil et al.). Reil et al. teaches that plastic covered rollers conventionally employ disks on the shaft to prevent the plastic tube to slide off the shaft (column 1, lines 9-15 of English language equivalent U.S. 6,444,065). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add disks on the shaft of the invention of Aser et al. because Reil et al. teaches the known advantages in preventing slippage of the covering of a roll.

### ***Conclusion***


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hsu shows a transfer roller on a shaft in a hand held film transfer tool. Budinger et al., Chapman, and Seckel each show a heat shrinkable polymeric tube on a shaft.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Osele whose telephone number is 703-308-2063.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Art Unit: 1734

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read 'Mark A. Osele', written in a cursive style.

**MARK A. OSELE**  
**PRIMARY EXAMINER**

October 21, 2002